

REMARKS

Claims 1, 4, 6, 9, 11, 13-14 and 16 are pending in this application.

In the Office Action, the Examiner rejected claims 1, 4, 6, 9, 11, 13-14 and 16 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Examiner stated that adequate support was not provided for the amendment specifying that component (a) is a monomeric halogenated alkylphosphate ester non-aromatic organic flame retardant in the previous response. This rejection is respectfully traversed.

Support for component (a) being a monomeric halogenated alkylphosphate ester non-aromatic organic flame retardant can be found throughout the specification and in particular at page 2, lines 17-27 of the specification reproduced below.

The monomeric halogenated flame retardant that forms one essential component of the blends of the present invention are those flame retardants additives that have hitherto been used in conferring flame retardancy on polyurethane foams (especially flexible polyurethane foams).

One representative class that can be selected include the halogenated phosphate esters containing from about 1 to about 5 carbon atoms in their alkyl groups. Representative additives include: tris(dichloropropyl) phosphate; tris (2-chloroethyl) phosphate; tris(dibromopropyl) phosphate; tris(bromochloropropyl)phosphate; and the like.

As can be seen from the passage reproduced above, non-aromatic halogenated phosphate esters containing from about 1 to about 5 carbon atoms are listed as one representative class of monomeric halogenated flame retardants of the claimed invention. Although the specification does not specifically use the term “non-aromatic,” one skilled in the art would understand that the representative examples provided are in fact “non-aromatic” and therefore support the amended claims. Accordingly, the Applicants respectfully request that the rejection of claims 1, 4, 6, 9, 11, 13-14 and 16 under 35 U.S.C. §112, first paragraph be reconsidered and withdrawn.

In the Office Action, claims 1, 4, 6, 9, 11, 13-14 and 16 have been rejected under 35 U.S.C.103(a) as allegedly being unpatentable over Fearing ('534 or '633) in view of Hardy et al. ('035) and Biranowski ('200). For the reasons set forth below, the Applicants respectfully disagree.

In making the rejection, the Examiner acknowledges that neither the oligomeric organophosphate flame retardant (component b) nor the monomeric halogenated alkylphosphate ester non-aromatic organic flame retardant (component a) of the present invention is taught by the primary reference. In other words, the Examiner has acknowledged that the primary reference, i.e., Fearing, does not teach either of the two flame retardant components in the blend of the present invention. Instead, the Examiner relies on Fearing for establishing that "either reactive or non-reactive oligomeric flame retardants may be blended with other flame retardants to produce a flame retardant blend." (See Office Action bottom of page 3).

However, merely combining two or more flame retardants to make a new flame retardant blend is not Applicants' invention. That is, Applicants are not claiming to have invented any and all flame retardant blends containing two or more flame retardants but instead Applicants are claiming the particular blend of flame retardants recited in the claims; a blend that is neither disclosed and/or suggested by the combination of references cited by the Examiner and a blend that has resulted in unexpected flame retardant results, as discussed in the specification and below. The Examiner's statement that the flame retardants are known does not relieve the Examiner of the requirement when making the obviousness rejection, to show where in the prior art the suggestion and/or motivation to blend the specific flame retardants recited in the claims is located.

In view of the foregoing, the Applicants respectfully assert that the Examiner has not provided the requisite motivation and/or suggestion to blend a monomeric halogenated alkylphosphate ester non-aromatic flame retardant (component a) with the oligomeric organophosphate flame retardant (component b). However, that is what is required to make a *prima facie* case of obviousness.

In essence, if Fearing et al. was to be considered to provide sufficient motivation and/or suggestion to do what the Applicants have done, and it does not, then any composition containing any and all phosphonates, phosphates or phosphonate/phosphate hybrids and another component would be considered obvious. A conclusion that is simply not possible. Therefore, in view of the lack of suggestion and/or motivation to do what the Applicants have done, Applicants respectfully request that the rejection of claims 1, 4, 6, 9, 11, 13-14 and 16 be reconsidered and withdrawn.

Moreover, as can be seen from the table listing the results of Examples 9-15 at page 9 of the specification and reproduced below, the actual amount of flame retardants of the blends listed needed to pass the California 117 flame retardancy standardized test was unexpectedly less than what would have been predicted from a simple mathematical theoretical calculation of the same blends.

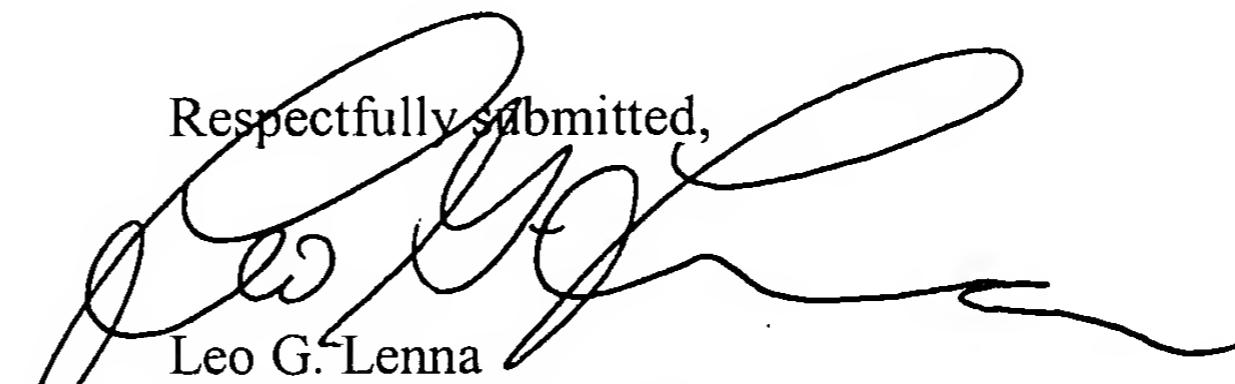
Flame Retardant	Actual	Theoretical
100% PEEOP	5	5
1 PEEOP: 1 FR-2	6	10
1 PEEOP: 2 FR-2	7	11.7
1 PEEOP: 3 FR-2	6	12.5
1 PEEOP: 6 FR-2	8	13.6
1 PEEOP: 10 FR-2	8	14.1
100% FR-2	15	15

Therefore, since the Examiner has not provided sufficient suggestion/motivation required to maintain a *prima facie* case of obviousness and moreover, even if a *prima facie* case had been made, since the claimed blend of flame retardants results in a blend having better properties than expected, it would not have been obvious to do what the Applicants have done.

In essence, what the Examiner's rejection of the claims boils down to is that one "**could have**" or "**would have been able to**" do what the Applicants have done. That, however, is not the standard under 35 U.S.C. §103(a) and has long been rejected as a substitute for the elements required of an Examiner to meet his burden of establishing a *prima facie* case of obviousness. *Ex parte Levengood*, 28 USPQ 1300, 1301; and *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App 1964).

Accordingly, for all of the foregoing reasons, the Applicants respectfully request that the rejection of Claims 1, 4, 6, 9, 11, 13-14 and 16 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

In view of the foregoing, favorable action on the merits and allowance of all the pending claims is respectfully requested.

Respectfully submitted,

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